REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed February 22, 2005. Through this response, claims 13-26 have been amended. Reconsideration and allowance of the application and pending claims 1-26 are respectfully requested.

I.   Allowable Subject Matter

Applicant appreciates the Examiner's indication that claims 7-12, 15-19 and 22-26 would be allowable if rewritten to include all of the limitations of the base claim and any intervening claims.

In that it is believed that every rejection has been overcome, it is respectfully submitted that each of the claims that remains in the case is presently in condition for allowance.

II.   Claim Rejections - 35 U.S.C. § 101

Claims 13-26 have been rejected under 35 U.S.C. § 101 because the claimed invention is allegedly directed to non-statutory subject matter. In particular, the Office Action recites the following on page 4:

> Claims 13 and 20 recites the information "a scanner comprising a computer readable medium..." which are non-statutory. A program is functional descriptive material, and is only statutory when embodied in a computer readable medium. Applicant may overcome this rejection by rewriting the limitation "a program product for making a computer execute image processing" as "A computer medium or a computer readable medium storing or comprising..."

Applicant has amended claims 13-26. In that it is believed that the rejection under 35 U.S.C. § 101 has been overcome by these amendments, Applicant respectfully requests that the rejection of these claims be withdrawn.

III.   Claim Rejections - 35 U.S.C. § 103(a)

A.   Statement of the Rejection

Claims 1-6, 13, 20 and 21 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Burkhardt et al.* ("*Burkhardt*," U.S. Pat. No. 5,218,457). Applicant respectfully traverses this rejection.

B.   Discussion of the Rejection

As has been acknowledged by the Court of Appeals for the Federal Circuit, the U.S. Patent and Trademark Office ("USPTO") has the burden under section 103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. *See In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Accordingly, to make a proper case for obviousness, there must be a prior art teaching or established knowledge that would suggest to a person having ordinary skill in the pertinent art to fill the voids apparent in the applied reference. It is respectfully asserted that no such case has been made in the outstanding Office Action.

Independent Claim 1

Claim 1 recites (with emphasis added):

A method for automatically scaling an image, the method comprising:
scanning an original image at an initial scanning resolution;
detecting lateral edges of the original image;
determining the width of the original image based upon the detected lateral edges;
making a size presumption of the original image based upon the determined width;
making a scanning resolution determination based upon the size presumption; and
continuing scanning of the original image based upon the scanning resolution determination.

Applicant respectfully submits that *Burkhardt* fails to disclose, teach, or suggest the emphasized claim features. The Office Action references col. 2, lines 28-32 of *Burkhardt* for the "making a size presumption" element and col. 3, lines 15-25 for the "making a scanning resolution determination" of independent claim 1. Applicant has reproduced these two sections below:

[col. 2] Automatic scanning widths are also provided, together with image enhancement algorithms including edge detection algorithms to increase the speed of scanning and the quality of the data produced by the present invention.

[col. 3] selecting a contiguous subset of detector arrays of the CCD detector array means which fall within the scan width of the documentary data and selecting a predetermined dead time between the raster lines of data to variably control the scanning speed of the scanning system to control the average data output rate; display means for electronically displaying the scanned documentary data in real time with a preselected variable resolution allowing varying amounts of the scanned documentary data to be displayed.

With regard to the col. 2 excerpt, this section simply states that "automatic scanning widths are also provided." In other words, there is no discussion in this section regarding the making of a "size presumption of the original image based on the determined width," as recited in independent claim 1.

With regard to the col. 3 excerpt, the variable scanning resolution is described as "preselected," which does not disclose, teach, or suggest "making a scanning resolution determination based upon the size presumption," as recited in independent claim 1. Further, the resolution appears to be "variable" in the sense that the resolution can be modified <u>post-scan</u> to provide a different output resolution, as shown in Figure 21. In other words, the scan is at a preselected resolution throughout the scan, and may be modified after the scan is complete. This operation of adjusting the resolution post-scan does not disclose, teach, or suggest "continuing scanning of the original image based upon the scanning resolution determination," as recited in independent claim 1. Thus, Applicant respectfully submits that *Burkhardt* does not disclose, teach, or suggest the emphasized claim features, and respectfully requests that the rejection be withdrawn.

Additionally, Applicant disagrees with the Office Action assertion of obviousness. Clearly, *Burkhardt* does not teach continuing the scanning based upon the scanning resolution determination, since the resolution appears to be either predetermined, or adjusted post-scan in *Burkhardt*, as explained above. Without this suggestion or motivation, one skilled in the art would not combine *Burkhardt* with what the Office Action appears to allege is well-known knowledge in the art.

Further, the Office Action appears to be taking Office Notice or a finding of well-known art. If this is true, Applicant respectfully traverses. The Manual of Patent Examining Procedure (MPEP) defines the standard for taking official notice. As provided in MPEP § 2144.03:

Official notice without documentary evidence to support an examiner's conclusion is permissible only in some circumstances. While "official notice" may be relied on, these circumstances should be rare when an application is under final rejection or action under 37 CFR 1.113. Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. As noted by the court in *In re Ahlert*, 424, F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be "capable of such instant and unquestionable demonstration as to defy dispute" (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)).

As provided in MPEP § 2144.03 (emphasis added):

If applicant adequately traverses the examiner's assertion of official notice, *the examiner must provide documentary evidence in the next Office action* if the rejection is to be maintained. See 37 CFR 1.104(c)(2).

Accordingly, if the Examiner is impliedly providing an argument of Official Notice or well-known art, Applicant traverses the Examiner's use of the same. Because of this traversal, the Examiner must support his finding with evidence, or withdraw the official notice determination.

Also, the Office Action provides the following assertion on page 2:

Applicant has not disclosed that continuing scanning of the original image based upon the scanning resolution determination provides an advantage, is used for a particular purpose or solves a stated problem.
Applicant respectfully disagrees.

The Background section of Applicant's application, particularly page 2, points out some problems with conventional systems, including the use of a pre-set optical resolution. This section is particularly relevant in light of the fact that *Burkhardt* appears to make use of a pre-set optical resolution that is variable only after scanning.

In summary, a *prima facie* case for obviousness has not been made against independent claim 1. Therefore, Applicant respectfully submits that independent claim 1 is patentable over *Burkhardt*.

Because independent claim 1 is allowable over *Burkhardt*, dependent claims 2-12 are allowable as a matter of law for at least the reason that the dependent claims 2-12 contain all elements of their respective base claim. See, *e.g.*, *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

Independent Claim 13

Claim 13 recites (with emphasis added):

(Currently Amended) A computer readable medium having a computer program configured to provide automated image scaling functionality, the computer readable medium comprising:
logic configured to detect the positions of lateral edges of the original image;
logic configured to determine the width of the original image based upon the positions of the lateral edges;
logic configured to make a size presumption of the original image based upon the determined width; and
logic configured to make a scanning resolution determination based upon the size presumption.

Applicant respectfully submits that *Burkhardt* fails to disclose, teach, or suggest the emphasized claim features. The Office Action references col. 2, lines 28-32 of *Burkhardt* for the "logic configured to make a size presumption" element and col. 3, lines 15-25 for the "logic configured to make a scanning resolution determination" of independent claim 13. With regard to the col. 2 excerpt, this section simply states that "automatic scanning widths are also provided." In other words, there is no discussion in this section regarding the making of a "size

presumption of the original image based on the determined width," as recited in independent claim 13.

With regard to the col. 3 excerpt, the variable scanning resolution is described as "preselected," which does not disclose, teach, or suggest making "a scanning resolution determination based upon the size presumption," as recited in independent claim 13. Thus, Applicant respectfully submits that *Burkhardt* does not disclose, teach, or suggest the emphasized claim features, and respectfully requests that the rejection to independent claim 13 be withdrawn.

Because independent claim 13 is allowable over *Burkhardt*, dependent claims 14-19 are allowable as a matter of law.

Independent Claim 20

Claim 20 recites (with emphasis added):

> A scanner, comprising:
> means for initially scanning an original image at an initial scanning resolution;
> means for detecting the relative positions of lateral edges of the original image;
> means for determining the width of the original image based upon the positions of the lateral edges;
> *means for making an initial size presumption of the original image based upon the determined width;*
> *means for making a first scanning resolution determination based upon the initial size presumption; and*
> *means for continuing scanning of the original image based upon the first scanning resolution determination.*

Applicant respectfully submits that *Burkhardt* fails to disclose, teach, or suggest the emphasized claim features. The Office Action references col. 2, lines 28-32 of *Burkhardt* for the "means for making an initial size presumption" element and col. 3, lines 15-25 for the "means for making a first scanning

resolution determination" of independent claim 20. With regard to the col. 2 excerpt, this section simply states that "automatic scanning widths are also provided." In other words, there is no discussion in this section regarding the means for making "an initial size presumption of the original image based on the determined width," as recited in independent claim 20.

With regard to the col. 3 excerpt, the variable scanning resolution is described as "preselected," which does not disclose, teach, or suggest "means for making a first scanning resolution determination based upon the initial size presumption," as recited in independent claim 20. Further, the resolution appears to be "variable" in the sense that the resolution can be modified post-scan to provide a different output resolution, as shown in Figure 21. In other words, the scan is at a preselected resolution throughout the scan, and may be modified after the scan is complete. This operation of adjusting the resolution post-scan does not disclose, teach, or suggest "means for continuing scanning of the original image based upon the first scanning resolution determination," as recited in independent claim 20. Thus, Applicant respectfully submits that *Burkhardt* does not disclose, teach, or suggest the emphasized claim features, and respectfully requests that the rejection be withdrawn.

Additionally, Applicant disagrees with the Office Action assertion of obviousness. Clearly, *Burkhardt* does not teach continuing the scanning based upon the scanning resolution determination, since the resolution appears to be either predetermined, or adjusted post-scan in *Burkhardt*, as explained above. Without this suggestion or motivation, one skilled in the art would not combine *Burkhardt* with what the Office Action appears to allege is well-known knowledge in the art.

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Further, the Office Action appears to be taking Office Notice or a finding of well-known art. If this is true, Applicant respectfully traverses this finding. The Manual of Patent Examining Procedure (MPEP) defines the standard for taking official notice, as explained above. Accordingly, if the Examiner is impliedly providing an argument of Official Notice or well-known art, Applicant traverses the Examiner's use of the same. Because of this traversal, the Examiner must support his finding with evidence, or withdraw the official notice determination.

Also, the Office Action provides the following assertion on page 2:

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Applicant respectfully disagrees. The Background section of Applicant's application, particularly page 2, points out some problems with conventional systems, including the use of a pre-set optical resolution. This section is particularly relevant in light of the fact that *Burkhardt* appears to make use of a pre-set optical resolution that is variable only after scanning.
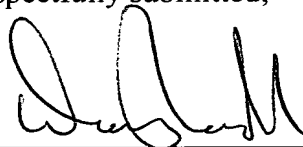
In summary, a *prima facie* case for obviousness has not been made against independent claim 20. Applicant respectfully submits that independent claim 20 is patentable over *Burkhardt* and that the rejection of independent claim 20 should be withdrawn.

Because independent claim 20 is allowable over *Burkhardt*, dependent claims 21-26 are allowable as a matter of law.

CONCLUSION

Applicant respectfully submits that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

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